



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/368,429	08/05/1999	FUMIHIKO YAMAGUCHI	0950-0110P	5516

2292 7590 07/25/2003

BIRCH STEWART KOLASCH & BIRCH
PO BOX 747
FALLS CHURCH, VA 22040-0747

EXAMINER

BEFUMO, JENNA LEIGH

ART UNIT	PAPER NUMBER
----------	--------------

1771

22

DATE MAILED: 07/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No. 09/368,429		Applicant(s) YAMAGUCHI ET AL.	
Examiner Jenna-Leigh Befumo		Art Unit 1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 5-14 is/are pending in the application.
- 4a) Of the above claim(s) 3, 6-9 and 11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 5, 10 and 12-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: |

DETAILED ACTION

Response to Amendment

1. Amendment E, submitted as Paper No. 21 on June 10, 2003, has been entered. Claims 1 and 10 have been amended. Therefore, the pending claims are 1 – 3 and 5 – 14. Claims 3, 6 – 9 and 11 are withdrawn from consideration as being drawn to a nonelected invention.
2. Amendment E is sufficient to overcome the 35 USC 102 and 35 USC 103 rejections based on Sargent et al. (5,316,850) set forth in the previous Office Action since Sargent fails to teach using the claimed triazine structure. Instead Sargent teaches the triazine ring should be bonded to specific end groups and it would not have been obvious to one of ordinary skill in the art to substitute the claimed triazine structure.
3. Applicant's arguments (Amendment E, pages 12 – 14) are sufficient to overcome the 35 USC 103 rejections based on Kato et al. (5,349,003) set forth in sections 7, 8, and 11 of the previous Office Action since Kato does not teach using a fluoroalkyl-containing compound as required in the composition.

Claim Rejections - 35 USC § 103

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
5. Claims 1, 2, 10, and 13 stand rejected under 35 U.S.C. 103(a) as being unpatentable over JP 59150175 A in view of Pacifici et al. for the reasons of record.
6. Claim 5 stands rejected under 35 U.S.C. 103(a) as being unpatentable over JP 59150175 A in view of Pacifici et al. as applied to claim 1 above, and further in view of Kubo et al. for the reasons of record.

7. Claims 1, 2, 10, 13, and 14 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Amimoto et al. (5,143,991) in view of Kato et al. and Pacifici et al. for the reasons of record.
8. Claim 12 stands rejected under 35 U.S.C. 103(a) as being unpatentable over JP 59150175 A in view of Pacifici et al. as applied to claim 1 above for the reasons of record.
9. Claim 12 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Amimoto et al. in view of Kato et al. and Pacifici et al. as applied to claim 1 above for the reasons of record.

Response to Arguments

10. Applicant's arguments filed June 10, 2003 have been fully considered but they are not persuasive. The Applicant argues that the rejections based on JP 59150175 A should be withdrawn since the urea or urethane component taught by JP 59150175 A is outside the scope of the claim due to the transitional language "consisting essentially of" (Amendment E, page 12). The Examiner agrees that the phrase "consisting essentially of" limits the claims to the specified materials and additional materials that do not materially affect the basic and novel characteristics of the claimed invention, as set forth in MPEP § 2111.03. However, the MPEP states that the burden is on the Applicant to show that additional steps or materials would materially change the characteristics of the Applicant's invention, and thus, are excluded by the recitation of "consisting essentially of" language.

In the present case, the Applicant argues that the urea group or urethane group required by JP 59150175 A materially affects the invention because Example 2 shows that the urea group or urethane group is essential for superior seam shift resistance. Now while this example does show that the additional component does provide improved seam shift resistance, this example fails to demonstrate how the urea group or urethane group would *materially affect the basic and novel characteristics of the claimed invention*. The Applicant's invention is concerned with the stain

resistance properties produced by the claimed composition, and not the seam shift resistance. Therefore, the fact that the urea or urethane group affects the seam shift resistance is irrelevant when determining how the urea or urethane group would materially affect the novel characteristics of the claimed invention, or in other words, how the urea or urethane group would hinder or destroy the stain resistance of the claimed coating composition. In fact, since JP 59150175 A teaches the composition is still used for stain resistance with the urea or urethane component then it is reasonable to presume the urea or urethane component would in no way materially affect the stain resistance of the coating composition. Hence, the urea or urethane group are not excluded by the “consisting essentially of” language since the Applicant has not shown that the urea or urethane group would in fact materially affect the stain resistance of the claimed coating composition. Therefore, the rejections are maintained.

11. With respect to the rejection based on Amimoto et al. the Applicant has provided no evidence that the additional components would materially affect the stain resistance of the composition. Thus, the rejection based on Amimoto et al. is maintained since the Applicant has not met the burden of showing that the additional components materially affect the basic and novel characteristics of the claimed invention.

12. Finally, absent a clear indication in the specification or claims of what the basic and novel characteristics actually are, “consisting essentially of” will be construed as equivalent to “comprising.” See MPEP § 2111.03. In other words, the Applicant is required to define what is considered to be outside the scope of the claims. Would all additives, modifying anything from the color of the composition to the UV resistance, be outside of the scope of “consisting essentially of.” The specification provides no guidance as to what components or additives would materially affect the novel characteristics of the claimed invention. Therefore, with no evidence to show otherwise,

Art Unit: 1771

the phrase "consisting essentially of" is interpreted as "comprising." Until the Applicant clearly establishes what is considered to be outside of the scope of "consisting essentially of" and provides evidence to show how the additional components in the cited prior art affect the novel characteristics of the present invention, i.e., the stain resistance properties, the rejections are maintained.

Conclusion

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jenna-Leigh Befumo whose telephone number is (703) 605-1170. The examiner can normally be reached on Monday - Friday (8:00 - 5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (703) 308-2414. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Art Unit: 1771

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Jenna-Leigh Befumo
July 22, 2003



CHERYL A. JUSKA
PRIMARY EXAMINER